

Serial No.: 10/563,660  
Docket No.: 09792909-6521  
Amendment dated August 13, 2009  
Reply to the Office Action of May 13, 2009

## **REMARKS**

### **A. Introduction**

Claims 1-16 were pending and under consideration in the application.

In the Office Action of May 13, 2009 ("the Office Action"), claims 1-16 were rejected as obvious.

In response, the rejections are traversed. Reconsideration and allowance of the pending claims are requested in view of the following remarks.

### **B. Rejection under 35 USC §103**

Claims 1-10 were rejected under 35 U.S.C. §103 as unpatentable over U.S. Patent No. 6,612,691 to Koitabashi in view of U.S. Patent No. 5,591,514 to Hirose. Applicant traverses these rejections for at least the following reasons.

Independent claims 1 and 4 recite, *inter alia*, inks having "a surface tension of 25 to 45 mN/m at 23°C." As provided discussed in the Specification, an ink with the claimed surface tension at the claimed temperature advantageously provides high-definition images having a mixture of colors without blots. See Spec. paras. 0014 and 0035.

Koitabashi, is silent regarding an ink with a surface tension at 23°C and is, therefore, unable to provide the aforementioned benefits provided by the present general inventive concept. See the Office Action, para. 7. Rather, Koitabashi illustrates using ink in a heated environment, i.e., on a heated recording medium, to increase penetrativeness thereby providing a higher recording density. See Koitabashi, Summary, figs. 14, 15, and 17-19, and corresponding portions of the specification. Thus, Koitabashi discloses exactly the opposite of the present general inventive concept by requiring a completely different approach to the ink employed.

Further, the art of record does not remedy the Koitabashi deficiency. Hirose is limited to an ink having a surface tension of 45 to 50 dyne/cm at 25 degrees Celsius, which is not the same as an inks having "a surface tension of 25 to 45 mN/m at 23°C," as recited by

Serial No.: 10/563,660  
Docket No.: 09792909-6521  
Amendment dated August 13, 2009  
Reply to the Office Action of May 13, 2009

independent claims 1 and 4. Thus, Hirose also fails to disclose or fairly suggest all of the recitations of independent claims 1 and 4.

Accordingly, independent claims 1 and 4 are patentable over the references and withdrawal of these rejections and allowance of these claims are earnestly solicited. Likewise, claims 2, 3, and 5-16 depend from either independent claims 1 or 4 and include all of the limitations of independent claims 1 and 4. Accordingly, dependent claims 2, 3, and 5-16 are also allowable over these references for at least the same reasons discussed above with respect to claims 1 and 4.

#### C. Conclusion

It is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, there being no other objections or rejections, this application is in condition for allowance, and a notice to this effect is earnestly solicited.

If any further fees are required in connection with the filing of this amendment, please charge the same to our Deposit Account No. 19-3140.

Respectfully submitted,  
SONNENSCHEIN NATH & ROSENTHAL LLP

By /Adam C. Rehm/  
Adam C. Rehm, Reg. No. 54,797  
P.O. Box 061080  
Wacker Drive Station, Sears Tower  
Chicago, IL 60606-1080  
816-460-2542 (telephone)  
816-531-7545 (facsimile)

ATTORNEYS FOR APPLICANT